

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

45251-46701

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January 5, 2007

Signature

Joseph M. Rolnicki

Typed or printed

name

Joseph M. Rolnicki

Application Number

10/803,839

Filed

March 18, 2004

First Named Inventor

Kurple et al.

Art Unit

3611

Examiner

Silbermann, Joanne

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number

32,653

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attorney or agent acting under 37 CFR 1.34.

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DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below".☒

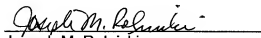
\*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Joseph M. Rolnicki  
Reg. No. 32,653

In re application of William M. Kurple et al.	:	
	:	
Serial No.: 10/803,839	:	Examiner: SILBERMANN, JOANNE
	:	
Filed: March 18, 2004	:	Group Art Unit: 3611
	:	
For: MULTI-USE FLOOR SIGN	:	
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**PRE-APPEAL REQUEST FOR REVIEW**

The following remarks are presented in response to the Final Rejection mailed October 10, 2006.

## REMARKS

There are clear errors made in the Final Rejection of the claims. These errors are pointed out below. It is requested that the Final Rejection be reviewed to avoid an appeal of the rejections with these clear errors present.

Claims 1-6, 10-16, 20-26, 30-34, 36-46, 48, and 49 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Ericson No. 2,208,213. Of these rejected claims, claims 1, 10, 20, 30, and 36 are independent claims. Each of these independent claims recites subject matter of the invention that is not identically disclosed by the Ericson reference. Thus, there is a clear error in the rejections. It is therefore submitted that the independent claims 1, 10, 20, 30, and 36 are allowable over the Ericson reference, and that their dependent claims are allowable over the Ericson reference.

It is a fundamental tenant of patent law that for a prior art reference to anticipate claimed subject matter, the reference must identically show every element of the claimed subject matter.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

*In Re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates the claims of anticipation.

*Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*, 39 U.S.P.Q.2d 1969, 1980 (Utah 1996).

Each of the independent claims of the application includes a common novel feature of the invention that is not identically shown by the Ericson reference. Because

this feature that is common to all of the independent claims is not identically shown by the Ericson reference, this degree of physical difference is sufficient to invalidate the anticipation rejection under the above-cited case law. Maintaining the rejection of the claims in view of the Ericson reference is based on clear errors.

Independent claim 1, among other features of the invention, requires that a movable panel be movable along the runner between a first position where the movable panel is generally parallel to the first surface of the first support panel, and a second position where the movable panel is generally parallel to the second surface of the second support panel.

In the rejection of the claims, the display binder of the Ericson reference is interpreted to have support panels 7, 8 and a movable panel 4. However, as shown in Figure 4, in one position of the movable panel 40 the panel is generally parallel with one support panel 7, but in the second position of the movable panel 4, it is not generally parallel with the second support panel 8. Therefore, the Ericson reference does not identically show the feature of claim 1 described above, and this physical difference is sufficient to invalidate the anticipation rejection of claim 1. Claim 1 and its dependent claims 2-9 are therefore allowable over the Ericson reference. The rejection of the claims is based on a clear error.

In a similar manner, independent claim 10 recites at least one movable panel that is movable along the runner between a first position where the panel is generally parallel to the first support panel, and a second position where the movable panel is generally parallel to the second support panel. As explained above with regard to claim 1, this feature of the invention is not identically shown by the Ericson reference. This

physical difference invalidates the anticipation rejection of claim 10 in view of the Ericson reference, and claim 10 and its dependent claims 11-19 are allowable over the prior art.

In a similar manner, independent claim 20, among other features of the invention recites a movable panel that is movable along the runner between a first position where the movable panel is generally parallel to the first surface of one of the support panels, to a second position where the movable panel is generally parallel to a second surface of one of the support panels. As explained above with regard to claim 1, the Ericson reference does not identically show this feature of the invention. This physical difference invalidates the anticipation rejection of claim 20 in view of the Ericson reference, and claim 20 and its dependent claims 21-28 are allowable over the prior art.


In a similar manner, independent claim 30 recites moving the at least one movable panel from a first position where the panel is generally parallel to the first surface of one of the support panels, to a second position where the panel is generally parallel to the second surface of one of the panels. As explained above with regard to claim 1, this feature of the invention is not identically shown by the Ericson reference. This physical difference invalidates the anticipation rejection of claim 30 in view of the Ericson reference, and claim 30 and its dependent claims 31-35 are allowable over the prior art.

In a similar manner, independent claim 36 recites a movable panel that is rotatable between a first position where the panel is supported by one of the support panels, and a second position where the movable panel is supported by the other of the support panels. In viewing Figure 4 of the Ericson reference, it can be seen that the

movable panel 4 can be moved to a position where it is supported by one of the support panels 7, but when moved to its other position, it is not supported by the other support panel 8. Thus, the Ericson reference fails to identically show every feature of the invention recited in claim 36. This physical difference between the subject matter of claim 36 and the disclosure of the Ericson reference invalidates the anticipation rejection of claim 36, and claim 36 and its dependent claims 37-49 are allowable over the prior art. The rejection of the claims is based on a clear error.

With the explanation above, it is respectfully requested that the Final Rejection of the claims be reconsidered, and the Final Rejection be withdrawn.

Respectfully submitted,

  
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